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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,150	10/14/2004	Rudolf Waelti	2360-0421PUS1	9012
2292 7590 05/09/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER LEE, HWA S	
			ART UNIT 2886	PAPER NUMBER
			NOTIFICATION DATE 05/09/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

Application No.

10/511,150

Applicant(s)

WAELTI, RUDOLF

Examiner

Andrew Hwa S. Lee

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2886

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-17, 19-24 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers.

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

### *2114 [R-1] Apparatus and Article Claims - Functional Language*

## APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be

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inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959).

"[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Many limitations found in claims 10-24 are functional limitations and these limitations can be met by the prior art if the structure of the prior art is capable of performing the claimed functions. **Limitations with "adapted to" do not define structure.** It has been held that the recitation that an element is "adapted to" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

3. Claims 10-15 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Podoleanu et al. (US 5,975,697) in view of Mori et al (US 6,476,919).

Podoleanu et al. (Podoleanu hereinafter) show:

an optical measuring arrangement ("optical mapping apparatus")

an evaluation unit connect to the latter in signaling terms;

wherein said optical measuring arrangement and said evaluation unit having a modular configuration, said modular configuration further including,

a patient module (40, 6, 9, 10, 12),

an illuminating device providing short coherent radiation (50, 55, 57),

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a first optical fiber (3),  
an observation device (19,34) and  
a second optical fiber (measurement arm, 3, 4),  
wherein said patient module is connected detachably by said first optical fiber  
with said illuminating device.  
said patient module has at least one first fiber coupler part,  
said first optical fiber has a first counterpart,  
said illuminating device produces a first radiation conductible with said first  
optical fiber,  
said observation device is arranged in the patient module,  
said optical measuring arrangement has said second optical fiber guiding a second  
- radiation,  
said patient module has a second collimator (6,10,12) that converts said second  
radiation of said second optical fiber into a second free-space beam,  
a display (19),  
a Michelson interferometer type,

Podoleanu does not expressly show the use of optical couplers that makes portions of the system modular. Mori et al show a reflectometer using connectors in the arms of the interferometer. At the time of the invention, one of ordinary skill in the art would have used connectors in the apparatus of Podoleanu in order to improve portability, ease repairs to portions of the apparatus, and allow flexibility in choosing elements for the apparatus. All these reasons

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are well known to a skilled artisan for the use of connectors. Furthermore, the use of electrical connectors are also well known and would have been used for similar reasons as the optical connectors.

Furthermore, it has been held that rearranging parts of an invention and making an invention separable involves routine skill in the art. In re Japikse, 86 USPQ 70 and Nerwin v. Erlichman, 168 USPQ 177, 179.

Podoleanu also does not expressly show a collimating lens between the light source and the first optical fiber. Official Notice is taken that the use of a collimating lens is well know for directing light from a light source into an optical fiber and at the time of the invention, one of ordinary skill in the art would have used a collimating lens between the light source and the optical fiber in order maximize the amount of light from the light source into the first optical fiber.

4. Claims 16, 17, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Podoleanu in view of Mori et al as applied to claim 10 above, and further in view of Dogariu (US 6,256,102).

Podoleanu shows all the elements as discussed above and also shows the reference branch with two reflectors (two reflectors in the retroreflector), however Podoleanu does not use the two reflectors to divide the reference radiation.

Dogariu show a low-coherence Michelson interferometer wherein two reflectors (154, 158) are used in the reference arm of the interferometer. At the time of the invention, one of ordinary skill in the art would have produced a dual reference beam as shown by Dogariu in order to improved the signal-to-noise ratio by using both a collimated beam and a focused beam.

***Allowable Subject Matter***

5. Claim 18 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to show or to suggest an examination and/or treatment station having all the elements as presently claimed wherein an optical element in the reference branch covers said reflectors in succession with the second radiation.

***Response to Arguments***

7. Applicant's arguments filed 2/28/07 have been fully considered but they are not persuasive.

In response to Applicant's argument that Podoleanu is not modular, it has been held that rearranging parts of an invention and making an invention separable involves routine skill in the art. In re Japikse, 86 USPQ 70 and Nerwin v. Erlichman, 168 USPQ 177, 179. In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). In addition, Furthermore, arranging of parts remotely away from the patient is well known. For instance, probes are known to be used to examine patients where only the probe is near the patient and the probe is connected to the rest of the measuring device (e.g. computer, light source, detectors) only by optical fibers.

8. In response to Applicant's argument that Mori does not show ophthalmological examination, the Office was looking to Podoleanu for the teaching of the examination/treatment station, not Mori. Furthermore, the test for obviousness is not whether the features of a

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secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Hwa S. Lee whose telephone number is 571-272-2419. The examiner can normally be reached on Tue-Fr.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tarifur R. Chowdhury can be reached on 571-272-2800. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Hwa S. Lee  
Primary Examiner  
Art Unit 2886